

**REMARKS/DISCUSSION OF ISSUES**

Claims 1-3 are pending in the application. Claims 1-3 are rejected.

**Claims 1-3 are rejected under 35 USC 251**

Claims 1-3 are rejected under 35 USC 251 as being an improper recapture of broadened claimed subject matter surrendered during prosecution of the original application 08/891,611, issued as patent 5,986,400, upon which this reissue application is based.

Specifically, the limitation 'active layer made from a semiconducting conjugated soluble polymer' of claim 3 of this reissue application is said to be broader than cancelled claims 4 and 5 of the original application 08/891,611, and also broader than claim 1 of the original patent 5,986,400.

More specifically, the limitation 'active layer made from a semiconducting conjugated polymer selected from poly (3-alkylthiophene) and poly (p-phenylene vinylene) polymers', in combination with other elements of the device, is said to define claim 1 of the patent patentably over the prior art, so that the narrow scope of the claims of the patent was not an error within the meaning of Section 251, and the broader scope surrendered in the application cannot be recaptured here.

MPEP Section 1412.02 defines a three-step test for determining whether a recapture took place. The first step is to determine whether the scope of the claim was broadened. Applicant concedes such broadening of scope. The second step is to determine whether any broadening aspect of the claims

relates to surrendered subject matter. This step involves two sub-steps. As stated in the MPEP Section 1412.02(1)(B)(1)(A):

**It must first be determined whether there was any surrender of subject matter made in the prosecution of the original application which became the patent to be reissued. If an original patent claim limitation now being omitted or broadened in the present reissue application was originally relied upon by applicant in the original application to make the claims allowable over the art, the omitted limitation relates to subject matter previously surrendered by applicant. The reliance by applicant to define the original patent claims over the art can be by way of presentation of new/amended claims to define over the art, or an argument/statement by applicant that a limitation of the claim(s) defines over the art. To determine whether such reliance occurred, the examiner must review the prosecution history of the original application file (of the patent to be reissued) for recapture. The prosecution history includes the rejections and applicant's arguments made therein. If there was no surrender of subject matter made in the prosecution of the original application, again the analysis ends and there is no recapture. (emphasis added)**

Thus, reliance by Applicant to define claims over the art can be by way of 'presentation of new/amended claims to define over the art'. However, the limitation 'active layer made from a semiconducting conjugated polymer selected from poly (3-alkylthiophene) and poly (p-phenylene vinylene) polymers' was not added to claim 1 of the original patent (claim 13 of the original application) in order to define patentable subject matter over the prior art.

Reliance by Applicant to define claims over the art can also be by way of 'argument/statement' that a limitation defines over the art. However, Applicant made no such argument or statement. Rather, as pointed out in the remarks accompanying the amendment which inserted the limitation on December 21, 1998, the limitation was added to 'more clearly define the invention'.

Moreover, in the next Office action, the Examiner of the original application made no statement to indicate any understanding that the amendment was made to define over the art.

In response to Applicant's arguments that there was no reliance and therefore no recapture, the Examiner has merely asserted that 'the added limitation ... rendered claim 1 of (the original patent) patentable', but has not supported this assertion with any evidence from the prosecution history, as specifically required by MPEP Section 1412.02(1)(B)(1)(A). Indeed, this could not be done, since the prosecution history is devoid of any such supporting evidence.

Accordingly, claim 3 of this reissue application is not an attempt to recapture subject matter previously given up in order to define patentable subject matter, but rather is an attempt to claim subject matter which Applicant is entitled to claim but failed to claim previously through error. This is exactly the kind of situation which a reissue patent with broadened claims is designed to remedy.

Accordingly, it is urged that the rejection of claims 1-3 under 35 USC 251 as an improper recapture of previously surrendered subject matter is in error and should be withdrawn.

**Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting**

Claims 1-3 are also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of parent patent 5,705,888.

Claim 1 of this reissue application claims an active layer selected from the group consisting of poly (3-alkylthiophene) and poly (p-phenylene vinylene) (the latter referred to as 'PPV').

Claims 4 and 5 of parent patent '888 each claim an active layer of a specific poly (p-phenylene vinylene) polymer. Claim

4 calls for conjugated 2,5-substituted poly(p-phenylene vinylene), while claim 5 calls for poly(2-methoxy,5-(3,7-dimethyloctyloxy)-p-phenylene vinylene!. These compounds are derivatives of PPV, not PPV (see col. 3, lines 18 and 25-33 of the patent).

Moreover, claiming a specific PPV derivative would not suggest to the skilled artisan that it would be possible to claim PPV generally. The notorious unpredictability of the behavior of chemical compounds would serve to caution the skilled artisan against concluding that the claiming of a specific derivative of PPV for a particular purpose would indicate that PPV would also be suitable for such purpose.

Thus, claims 1 and 2 are not obvious over claims 1-5 of the parent patent '888.

Claim 3 calls for the semiconducting conjugated polymer to be soluble, and does not call for insulating areas in the first electrode layer.

In contrast, claims 1-5 of parent patent '888 call for patterned insulating areas in the first electrode layer, and do not call for the semiconducting conjugated polymer to be soluble.

Thus, claims 1-5 of parent patent '888 would not suggest to the skilled artisan the combination of elements claimed in claim 3.

Thus, claim 3 is not obvious over claims 1-5 of the '888 parent patent.

In summary, claims 1-3 are not obvious over claims 1-5 of the '888 parent patent, and it is urged that the double patenting rejection is in error and should be withdrawn.

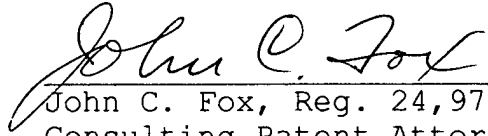
Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the

Amendment/Response

Response to Final Office action of 22 December 2005

pending claims, and find the application to be in condition for allowance.

Respectfully submitted,

  
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